

- C 28
Contd*
30. (Amended) The [gene product] method of claim ~~28~~²⁹₂₈ wherein the antigen is herpes simplex virus glycoprotein.
- E*
31. (Amended) The [gene product] method of claim ~~28~~²⁹₂₈ wherein the antigen is influenza virus hemagglutinin.
- E*
- 6/54* 32. (Amended) The [gene product] method of claim ~~28~~²⁹₂₈ wherein the antigen is hepatitis B virus surface antigen.--.

REMARKS

Claims 22 and 24 through 32 are now pending in this application.

Applicants are required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Applicants affirm the election to prosecute the species of hepatitis B virus surface antigen. Claims 22, 29 and 32 are generic to the elected species. It is urged that these claims are allowable and that remaining claims 24 through 28, 30 and 31, embracing a reasonable number of additional species, are likewise allowable.

The Examiner acknowledges applicants' Information Disclosure Statement (Paper No. 6) and requests applicants to submit copies of those references they would like to have considered by the Examiner in the prosecution of the instant application. However, as set forth in the IDS, a copy of each of the references was forwarded to the Patent and Trademark Office

in the predecessor applications identified in the IDS. In accordance with 37 C.F.R. 1.98(d),

A copy of any patent, publication or other information listed in an information disclosure statement is not required to be provided if it was previously cited by or submitted to the Office in a prior application, provided that the prior application is properly identified in the statement and relied upon for an earlier filing date under 35 U.S.C. 120.

Accordingly, it is respectfully requested that applicants' Form PTO-1449 be duly acknowledged by the Examiner and returned to applicants.

The present claims have been amended to define, in place of a gene product, a method for the production of a protein. The method includes infecting a culture of eukaryotic cells with the recombinant vaccinia virus under conditions suitable to allow expression of the protein, and isolating the expressed protein from the cell culture. The recitation of "gene product", objected to by the Examiner, is not used in the present claims as amended. Support for the amendment to the claims is found in the present specification, *inter alia*, on page 4, second paragraph to page 7, first paragraph. The methods defined in the present claims clearly distinguish over conventional methods for the production of proteins in *E. coli* and yeast.

PATENT
454310-2430
Paper No. 9

In view of these amendments, it is urged that the rejections of the claims based on the judicially created doctrine of obviousness-type double patenting over U.S. Patent Nos. 4,769,330, 4,603,112, 4,722,848 and 5,110,587; the rejection under 35 U.S.C. 101 on the basis of patentable utility; the rejections under 35 U.S.C. 112, first and second paragraphs; the rejection under 35 U.S.C. 102(b); and the rejection under 35 U.S.C. 102(e) are all obviated.

In view of the foregoing, entry of the amendment, favorable reconsideration of the claims and allowance of the application with claims 22 and 24 through 32 are respectfully requested.

A Notice of Allowance is earnestly solicited.

Respectfully submitted,

CURTIS, MORRIS & SAFFORD, P.C.
Attorneys for Applicants

By Robert F. Kirchner
Robert F. Kirchner
Reg. No. 31,034
(212) 840-3333